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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,597	06/29/2001	Michael E. Gardi	23952-0143	6502
29052 7590 07/16/2007 SUTHERLAND ASBILL & BRENNAN LLP 999 PEACHTREE STREET, N.E. ATLANTA, GA 30309			EXAMINER OYEBISI, OJO O	
			ART UNIT 3692	PAPER NUMBER
			MAIL DATE 07/16/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/893,597

Applicant(s)

GARDI ET AL.

Examiner

OJO O. OYEBISI

Art Unit

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 12-16, 18-20, 24 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-4, 6-8, 12-16, 18-20, 24, and 38-5 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

In the amendment filed on 04/18/2007, the following have occurred: applicants have amended claims 1, 7-8, 13, and 19-20 and added new claims 38-53. Claims 5, 9-11, 17, 21-23, 25, and 26-37 are cancelled. Therefore, Claims 1-4, 6-8, 12-16, 18-20, 24, and 38-53 are currently pending. The amendment filed on 04/18/2007 has added further limitations to the claims, such as the ones in claims 1, 8 and 13, which have rendered the patent application to have two or more independent and/or distinct inventions. As a result, the United States Patent and Trademark has to restrict the patent application.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 6-7, 13-16, 18-19, drawn to a method for presenting customer-specific supplemental information with billing information, comprising:  
receiving billing information associated with a customer of a biller;  
determining that the customer qualifies for presentment of a supplemental information item by transmitting a request to a customer relationship management system and receiving a response from the customer relationship management system including information indicating that the customer qualifies for presentment of the supplemental information item;  
generating a bill presentation including at least the received billing information and the supplemental information item; and presenting the generated bill presentation to the customer, classified in class 705,

Art Unit: 3692

subclass, 40.

- II. Claims 8-12, 20, 24, 38-53 drawn to a method for presenting customer-specific supplemental information with billing information, comprising: receiving billing information associated with a customer of a biller; determining that the customer qualifies for presentment of a first supplemental information item having a first priority; determining that the customer qualifies for presentment of a second supplemental information item having a second priority wherein one of the first priority and the second priority is higher than the other; determining that the first and the second supplemental information items are not allowed to be presented together; generating a bill presentation including at least the received billing information and one of the first and the second supplemental information items having the highest priority; and presenting the generated bill presentation to the customer, classified in class 705, subclass 40.
2. The inventions are distinct, each from the other because of the following reasons:
- Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method for presenting customer-specific supplemental information with billing information, comprising: determining that the customer qualifies for presentment of a **supplemental information item**; **modifying** the qualification information based on the received customer response information, whereas

Art Unit: 3692

invention II has a different utility and scope of determining that the customer qualifies for presentment of **a first supplemental information item having a first priority**; determining that the customer qualifies for presentment of a **second supplemental information item having a second priority** wherein one of the first priority and the second priority is higher than the other; **determining that the first and the second supplemental information items are not allowed to be presented together**. Hence Invention I has a different utility and scope than Invention II. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II.

Restriction for examination purposes as indicated supra is proper.


3. Applicants are advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RICHARD E. CHILCOT can be reached on (571)272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3692

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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